

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Amendments

In this response claims 2-4 have been amended in a manner which simultaneously overcomes the objections raised in paragraph #3 and the rejections under 35 USC § 112, second paragraph set forth in paragraph #4. More specifically, "medium" has not been changed to "document" in light of the amendment wherein claims 2-4 have been made dependent on claim 15. This amendment provides proper antecedent basis for the "locating" step recited therein and negates the need to correct "medium" to "document".

Rejections Under 35 USC § 102

1) The rejection of claims 2-5, 7-8, 15-18, 20, 22, 24-25 and 27 under 35 USC § 102(b) as being anticipated by Witek, is respectfully traversed.

In this response independent claim 5 has been amended to call for the communication addresses which are decoded from the communication mark to be different from that of the final address destination. This distinguishes over the Witek technique wherein an incoming fax is scanned and is then automatically routed to the named recipient(s) and/or those cc'd on the communication. That is to say, column 1, lines 11-29, of Witek discloses that:

. . . use of facsimile (Fax) transmissions is becoming increasingly popular as companies and business expands to nation-wide and global-wide markets. The need to communicate with remote locations is an increasingly important function. In the past, Fax

machines have been used to receive Fax transmissions from a phone line and print the Fax transmission to paper. The paper was then hand routed by a human user to a proper destination.

In many cases, the Fax could be lost in the recipient's in-basket, mis-routed, or routed long after the Fax was sent. In some cases, Faxes need to be logged on paper or in a database for future reference which takes a considerable amount of man hours. In addition, the Fax document, which are received in a paper format, cannot be electronically modified or changed by a recipient in a time efficient and easy manner. In addition, some Faxes are sent simply to pass information which need not be permanently fixed on paper. Due to the above complications, a more automated Fax logging and routing system is needed.

In other words, the Witek technique is directed to incoming communications and to a system which scans and automatically distributes the communications internally to the people named (addressees) on the incoming document. It is submitted that claim 5 as amended differentiates over this in that the addresses which are decoded are not those of the address at which the communication was initially received.

Claims 20, 22, 24-25 and 27, on the other hand, have been amended to call for the communication mark to be a non-text/image mark. Support for this claiming is found in the originally filed specification at page 3, line 28 – page 4, line 17, with respect to disclosure of the use of a machine readable code, digital encoding, "hiding the code in a primary image", a pattern of dots or lines, half-tone markings etc.

This distinguishes over Witek in which discloses that non-text or image data is placed aside and only text which can be read using an OCR technique is examined to determine if a string of characters match pre-memorized data. More specifically, at column 3. lines 14 – 35 it is set forth that:

. . . In some cases, a fax document will contain high resolution or low resolution graphics which may be drawings, figures, company logos, or the like. Typically, **these drawings within the pict fax file are not converted to text by the OCR software 16**, but remain in a graphics format. The OCR software 16 is typically looking for one or more pieces of information from this "cover sheet".

Once the **OCR software 16** has generated the **text fax file 17**, the control code 22 **initiates custom pattern recognition** via custom pattern recognition code 18. Custom pattern recognition code 18 contains a plurality of predetermined or preselected text or text strings. These text strings contain names which identify a destination of all potential faxes that can be received by computer 12. For example, if four people can receive faxes from the link establishes via computer 12 and the office network, four names will be stored in the custom pattern recognition code 18 to determine which of the four recipients should receive the fax. In many cases, one person or one destination will be the recipient of a fax, but in certain circumstances custom pattern recognition code 18 may find that several or multiple destinations are needed in order to route the fax properly.

It is therefore submitted that Witek does not use data which cannot be converted into text and therefore does not anticipate a non-text/image communication mark as now claimed.

- 2) The rejection of claims 11-13, 26 and 28 under 35 USC § 102(b) as being anticipated by Cass is respectfully traversed.

Column 16, 65 – column 17, line 16, of Cass is cited as disclosing a communication mark. This mark is disclosed as being an "X" or the like type of mark on a button site to indicated that an internet site link associated with this button is to be accessed. However, the last paragraph of claim 11 calls for the

communication mark to be a storage address to a location where a communication address is stored.

In that the Cass arrangement involves the use of a number of "buttons" or icons, and the selection process is performed by placing a communication mark (an "X" mark) on one or more of the buttons/icons in the manner shown in Fig. 21, it must be taken that the "X" mark per se is the claimed communication mark. This mark indicates a selection or decision, but it does not include a storage address per se as required in claim 11.

Claim 26 calls for the communication mark to be decoded and at least one internet address being obtained from the mark. It is submitted that the "X" selection mark cannot be decoded in the manner claimed. It is also submitted that an internet address cannot be obtained from the "X" mark per se.

Claim 28 distinguishes over Cass for the same reasons as set forth in connection with claim 26.

Rejections Under 35 USC § 103

- 1) The rejection of claims 9 and 10 under 35 USC § 103(a) as being unpatentable over Witek in view of Geshwind is, to the degree that it is still pertinent with respect to the claims as amended, respectfully traversed.

As noted above, Witek discloses ignoring non-text/image data and uses data which can be read and converted into text using OCR. Accordingly, while Geshwind may disclose the use of a bar code communication mark or the like, these types of marks would be ignored in accordance with the method utilized in Witek.

Therefore, without some clear teaching which would direct the hypothetical person of ordinary skill to ignore the intentions of Witek to focus on text strings and to attempt to incorporate marks which cannot be converted into text strings using OCR, it is submitted that this rejection must be considered to be untenable.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

The rejection is further untenable in that proper motivation has not been provided for the hypothetical person of ordinary skill to consider the purportedly obvious transfer of teachings. On page 15, of this Office Action, it is stated that "Witek's system would easily be modified to include Geshwind's teachings, as the systems share cumulative features, being additive in nature."

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

While the statements advanced in this Office Action may establish that Witek and Geshwind are of analogous art, it does not amount to proper motivation in accordance with the § 103 statute. In a nutshell, it is necessary for the hypothetical person of ordinary skill who is working with a complete lack of any knowledge of the claims and without any inventive activity, to be led to the claimed subject matter by the teachings which come from the references when considered as whole.

Cumulative knowledge is just knowledge. It does not contain guidance of the nature which is required in order to establish a *prima facie* case of obviousness.

Additionally, neither of the references would suggest that either suffers from any drawback or problem that the other may serve to overcome. Thus, again the hypothetical person of ordinary skill is without motivation in the form of a problem that would motivate consideration of combining teachings and thus again the rejection must be deemed untenable.

- 2) The rejection of claims 14 and 19 under 35 USC § 103(a) as being unpatentable over Witek in view of Cass, is to the degree that it is pertinent with respect to the claims as amended, is respectfully traversed.

In the same manner as above, this rejection carefully lists all of the claimed features can be found in the two references, and then makes the statement that motivation is found in the fact that the systems "share cumulative features, being additive in nature."

As noted above, shared cumulative features do not establish a *prima facie* case of obviousness in that proper motivation is not established.

Additionally, in connection with claim 19, it is states that Cass discloses the step of adding a communication mark to said information that "deletes" an address or a reference to an address from the located communication mark, in column 17, line 50 – column 18, line 65 (emphasis added). However, no disclosure can be found in this passage which is set forth below. Viz.:

FIG. 22 is a high-level flowchart for the method of Paper Web in one embodiment. These steps are carried out using appropriate components of system 10 and, more particularly, computer 100 under control of processor 105.

Initially, the user invokes Paper Web, for example, by calling computer 100 on the telephone or by scanning in a special start-up document. This causes Paper Web to output a hardcopy of the user's default page or pages (e.g., the user's home page or the user's "bookmark list" containing links to the user's favorite Web sites) to the user (step 2200).

Thereafter, Paper Web enters a work loop in which the user marks up instances of hardcopy Web page printouts in his or her possession (step 2210) and sends these instances to the computer, which follows the indicated links and sends back new printouts. The computer continually updates a cache of the Web pages previously visited by the user, so that these pages can be recognized if marked instances of the pages are presented as input.

More particularly, the loop begins with the user marking one or more links on a paper or other hardcopy instance of a Web page known to Paper Web (step 2210). A scanned, faxed, or other pixel image of this marked page instance is provided to system 10, sent to computer 100, and stored in memory 106 for use by processor 105 (step 2220).

Once the image of the marked page instance has been made available to processor 105, the image is used to find the corresponding known Web page in the cache (step 2230). This can be done, for example, by generating an image-based or other index from the marked page instance image. The cache stores associations between the indices of previously visited Web pages (i.e., pages known to the system and therefore usable as reference documents) and the contents of these pages. The cache can store the actual contents of each cached page (that is, the HTML representation of the page), or simply store the page's URL.

After the correct page has been found, processor 105 retrieves the image and hypertext link information for the page (step 2240). If the cache contains the HTML representation of the page, the processor can render the HTML directly to produce a bitmap and to determine where the active regions are in this bitmap. If the cache contains only the URL, the processor first can fetch the page from a Web server storing the reference documents.

Next, processor 105 extracts the user's mark from the marked

document instance by performing reference-based mark extraction (step 2250), using as the reference document image the rendered image of the cached page. That is, processor 105 compares the image of the user's marked page instance with the rendered image of the cached page to determine what links the user has marked. Preferably, Hausdorff registration and robust differencing techniques are used to accomplish this step, as described earlier in connection with Formless Forms.

Once the mark is extracted, processor 105 interprets the mark or marks to determine what links, if any, the user has selected (step 2260). This can be done, for example, by determining the proximity of the user's mark or marks to the pixels that represent the hypertext links of the page. In other words, Paper Web interprets the user's mark or marks by treating each mark as the paper-based equivalent of a mouse click. Just as a GUI-based Web browser can determine the location of a user's mouse cursor with respect to a rendered image of a Web page and thereby can determine what link, if any, the user has selected, here Paper Web can determine the location of the user's mark or marks with respect to the rendered image of the Web page and thereby can determine what link or links (if any) the user has selected. Thus, if the pixels of the user's mark intersect (or are nearby to, or otherwise indicate) pixels of the rendered Web page that correspond to Web page elements representing one or more hypertext links, these links are deemed to have been selected by the user.

Processor 105 follows any link or links that the user has selected and retrieves the Web pages indicated by these links (step 2270). Processor 105 computes index values for these pages and saves the index values, together with the page's HTML contents or URL as the case may be, in the cache (step 2271). In this way, the newly retrieved pages will be recognizable if, at a future time, the user wishes presents them to Paper Web in hopes of revisiting them. Also, processor 105 provides hardcopy output of the retrieved pages to the user (step 2272). At this point the loop can either continue (step 2280) or terminate, in which case Paper Web is exited (step 2290).

The rejection is therefore traversed in that the cited reference does not disclose the deletion and replacement feature.

Newly Added Claims

New claims 29-33 have been added in this response. Claim 29 claim limits the addresses which are obtained via the decoding to be at least that of the sending party and to allow the fax to be returned as confirmation for example, back to the sender. Claim 30 limits the communication mark of claim 5 to be a non-text/image type communication mark.

Claims 31 –33 limit the addresses being obtained directly from the communication mark. This is, of course, a limitation on the existing claim scope which is therefore both proper and supported by the claim language of the claims from which each respectively depends. These claims are patentable over the cited art for at least the reasons advanced above.

Conclusion

It is respectfully submitted that all of the pending claims are allowable over the cited art for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

By \_\_\_\_\_



Date April 2, 2003

HEWLETT-PACKARD COMPANY  
Customer No.: 022879

William T. Ellis  
Attorney for Applicant  
Registration No. 26,874